

### **REMARKS**

The non-final Office Action dated 10 September 2008 has been received and its contents carefully studied. The pending claims are claims 1-4 and 6-31. All claims stand rejected.

The pending independent claims are method claim 1, apparatus claim 11, apparatus claim 19, apparatus claim 21, program claim 22, storage medium claim 24, mobile phone claim 26, and apparatus claim 30.

At page 2 of the final Office Action, the specification is objected to for not defining the word “means.” Also, independent claims 19, 21, and 30 are rejected as non-statutory.

At page 3 of the Office Action, all of the independent claims (and several of the dependent claims) are rejected as anticipated by *Inoue* (U.S. Patent No. 6,332,024). At page 8 of the Office Action, dependent claims 28-29 and 31 are rejected as obvious from *Inoue*.

### **The Word “Means” in Claim 30 is Proper**

Applicant assumes that the word “means” in independent apparatus claim 30 is the reason for the objection regarding definition of the word “means” in the disclosure. Claim 30 is also rejected as non-statutory.

Applicant respectfully points out that claim 30 is a mean-plus-function claim corresponding to claim 11. Means-plus-function claims are specifically allowed by 35 U.S.C. § 112 Sixth Paragraph, which says: “An element in a claim for a combination may be expressed as a means....”

Consequently, the “means for performing” in claim 30 is, for example, the “electronic device” of claim 11. The “means for presenting” in claim 30 is, for example, the “graphic user interface” of claim 11.

Therefore, Applicant respectfully submits that the word “means” is clear and appropriate in the present application. Also, since claim 30 is virtually the same as claim 11, which has not been rejected as non-statutory, then clearly claim 30 must be statutory.

### **Rejections Under 35 U.S.C. § 101 of Claims 19 and 21 Should be Withdrawn**

Claim 30 is statutory for the reasons explained above. The non-final Office Action has also rejected claims 19 and 21 as non-statutory. Claims 19 and 21 are both independent apparatus claims.

The non-final Office Action states (at the top of page 3) that claims 19 and 21 are, at best, “functional descriptive material per se.” Applicant respectfully points out that, “Functional language does not, in and of itself, render a claim improper.” MPEP § 2173.05(g); also see *In re Swinehart*, 169 USPQ 226 (CCPA 1971). Rather, such a claim “is simply an apparatus claim including functional limitations,” and this mere fact “does not affect the analysis to be performed by USPTO personnel.” MPEP § 2106 (IV)(B).

Therefore, Applicant respectfully submits that claims 19 and 21 are statutory. Additionally, Applicant submits that the rejections of claims 19 and 21 under 35 U.S.C. § 101 are incomplete, because the rejection does not “identify the features of the invention that would render the claimed subject matter statutory if recited in the claim.” MPEP § 2106 (IV)(B).

#### **Brief Summary of Invention**

The present invention provides a method for displaying a menu on a display. This method includes activating a selection element, which causes a magnified version of the activated selection to appear, and also causes auxiliary elements to be displayed only in the active selection element.

The auxiliary elements include a directional indicator, and activating the directional indicator activates a different selection element. When the new selection element is activated, the auxiliary elements are no longer displayed in the selection element that was initially active, and instead auxiliary elements (including directional indicators) are displayed in the new selection element. This technique greatly facilitates navigation from one task to another.

#### **Brief Summary of the Cited *Inoue* Reference**

The portable terminal of *Inoue* has a display screen and also has a main “soft key” which can be rotated and which can also be pressed. The terminal additionally has a first auxiliary soft key and second auxiliary soft key, which can both be pressed. In this portable terminal of *Inoue*, for each communication mode, a function having the highest frequency of use is allocated to the

main soft key, and functions having the next highest frequency of use are allocated to the first auxiliary soft key and second auxiliary soft key. Marks representing the allocated functions are displayed on the display screen near these three keys, as a main-function icon and auxiliary-function icon.

**Reasons Why the Claim Should Not Have Been rejected as Anticipated by *Inoue***

The Office Action acknowledged at page 9 that, “Magnifying and Highlighting are not similar actions.” The Office Action also acknowledges at page 10 that “*Inoue et al.* teach the step of highlighting.”

Claim 1 discloses magnifying instead of highlighting, and therefore Applicant does not understand why present claim 1 is rejected as anticipated under 35 U.S.C. § 102(b). The *Inoue* reference discloses highlighting instead of magnifying. To anticipate a claim, the reference must teach every element of the claim. MPEP § 2131.

Additionally, the Office Action (at page 3) discusses “displaying a plurality of auxiliary elements (plurality of elements: G21 and G22) only in the one of the selection elements that has been activated (figure 6C).” However, figure 6C of the cited *Inoue* reference does not show any elements “G21 and G22”.

Perhaps the Office Action meant to say that the present claimed auxiliary elements are similar to C21 and C22 of *Inoue*’s Figure 6C. But that still does not make sense to the Applicant, because activating C21 and C22 does not initiate the procedure at the cited “column 9, lines 59 through column 10, line 26” (see page 4 of Office Action, line 6). This is very clear because C21 and C22 are not mentioned by *Inoue* until column 10, lines 33-35.

**Amendment of Present Independent Claims**

Merely to expedite prosecution, the independent claims are now amended without prejudice, by inserting an additional “wherein” clause. Much of the material in this new “wherein” clause is from claim 28, and therefore claim 28 is now cancelled. The new “wherein” clause also contains the following limitation: “making room within said one of the selection elements for said

plurality of directional indicators.” This limitation is supported at least by Fig. 3 of the present application, which shows that the messaging selection element **3** has been enlarged thereby making room for directional indicators **4a**.

All of the present claim amendments are fully supported by the specification, and introduce no new matter. The Office Action acknowledges at page 9 that *Inoue* “fail to clearly teach magnifying of said one of the selection elements includes increasing an apparent size.” Certainly, *Inoue* also fails to suggest that increasing the size makes room for the directional indicators.

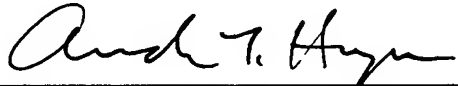
**Conclusion**

For all the foregoing reasons it is respectfully believed that all of the claims of the application are in condition for allowance and their passage to issue is earnestly solicited. Applicant respectfully requests that the rejections under 35 USC §102 based on *Inoue* be reconsidered and withdrawn. Applicant's attorney asks that the Examiner please call to discuss the present response by telephone, if anything in the present response is unclear or unpersuasive.

Respectfully submitted,

Dated: February 2, 2009

WARE, FRESSOLA, VAN DER  
SLUYS & ADOLPHSON LLP  
Building Five, Bradford Green  
755 Main Street, P.O. Box 224  
Monroe, CT 06468  
Telephone: (203) 261-1234  
Facsimile: (203) 261-5676  
USPTO Customer No. 004955

  
\_\_\_\_\_  
Andrew T. Hyman  
Attorney for Applicant  
Registration No. 45,858